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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,478	07/21/2003	Jean-Christophe Simon	032487-004	4522

<sup>7590</sup>  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER
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BROOKS, KRISTIE LATRICE

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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07/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/622,478

**Applicant(s)**

SIMON ET AL.

**Examiner**

KRISTIE L. BROOKS

**Art Unit**

1616

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-16, 18-22, 26, 27, 30-43 and 56 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16, 18-20, 26, 27, 30-43 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/19/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

1. Claims 2-16, 18-22, 26-27, 30-43 and 56 are pending. Claims 23-25 and 28-29 have been cancelled.
2. Claims 21-22 are withdrawn from further consideration as being drawn to the non-elected species requirement.
3. Receipt and consideration of Applicants remarks filed on January 23, 2009 is acknowledged.
4. Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

***New Ground of Rejection necessitated by Applicant's Amendment***

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 2-16, 18-20, 26-27,30-43 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm et al. (US 2002/0064509) in view of Christie et al. (US 6,325,847).

Applicant claims a goniochromatic/light reflecting cosmetic lip makeup composition, comprising (a) at least one goniochromatic coloring agent suited for creating a goniochromatic colored background and (b) an amount of light reflective particles suited for creating highlight points that are visible to the naked eye, wherein said reflective particles are different from the goniochromatic coloring agent and comprise particles of a natural or synthetic substrate at least partially coated with a layer of at least one metal, or comprise particles of a synthetic substrate at least partially coated with a layer of at least one metallic compound, said at least one metal being selected from the group consisting of Ag and alloys thereof, said at least one metallic compound being TiO<sub>2</sub>, formulated into (c) a topically applicable, physiologically acceptable medium therefor.

**Determination of the scope and content of the prior art**  
**(MPEP 2141.01)**

Grimm et al. teach a cosmetic makeup composition for use in lipsticks, lip glosses, foundations, eyeliners, etc., comprising at least one goniochromatic pigment and at least one lipophilic continuous phase (see the abstract and pp 1 paragraphs 1 and 4). The goniochromatic pigment may have an interferential multilayer structure, such as  $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{FeO}_3/\text{SiO}_2/\text{Fe}_2\text{O}_3$  (see page 1 paragraphs 8-11). The goniochromatic pigment may be present in the composition in the amount of 0.01 to about 50% by weight (see page 2 paragraph 14). The composition may contain at least one pigment other than the at least one goniochromatic pigment, such as, inorganic or organic particles, lakes, pearlescent and interferential pigments that may be provided in form of glitter, with a metallic color, for example, a substrate or core with an applied coating of a metal (e.g. titanium dioxide) (see page 3 paragraphs 27 and 29). The at least one pigment other than the at least one goniochromatic pigment may be present in an amount of up to 5% by weight (see page 3 paragraph 32). The composition may contain at least one fatty substance such as hydrocarbon oils, vegetable oils, silicon oils, etc. (see page 3 paragraph 21). The composition may be in the form of an anhydrous composition, oil-in-water emulsion, water-in-oil emulsion, etc. (see page 2 paragraph 17).

**Ascertainment of the difference between the prior art and the claims**  
**(MPEP 2141.02)**

Grimm et al. teach cosmetic makeup composition comprising goniochromatic pigments, a lipophilic continuous phase and a substrate coated with a metallic color (i.e.

titanium dioxide) but do not teach coating the substrate with at least one metal selected from Ag( i.e. silver). This deficiency is cured by the teachings of Christie et al.

Christie et al. teach precious metal color effect material (CEM) comprising a plurality of substrate platelets coated with a highly reflective first layer to light, a second layer encapsulating the first layer and a selectively transparent third layer (see the abstract, column 1 lines 65-67 and column 2 lines 1-9). The substrate can be mica glass flack, titanium dioxide coated with mica, etc (see column 2 lines 18-21). The highly reflective first layer can be precious metals, such as, silver, gold, etc (see column 2 lines 22-25). However, silver is preferred when employed as a reflective layer because it can maximize chromaticity of the reflected colors of the CEM (see column 2 lines 32-36). The degree of reflectivity for the first and third layer is 50-100% (see column 2 lines 9-14). The particle size of the platelet-shaped particles is about 5-250 $\mu$ m (see column 3 lines 1-5). The amount of pigment used can range from 1-30% depending on the specific type composition (see column 5 lines 29-53). The pigments are useful in cosmetics (see column 2 lines 64-67, and column 5 lines 1-2 and 29-53).

**Finding of prima facie obviousness**  
**Rational and Motivation (MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to incorporate light reflective particles at least partly coated with a layer of Ag (i.e. silver) into cosmetic

makeup composition taught by Grimm et al. because Grimm et al. teaches that the cosmetic makeup composition can contain additional pigments, including substrates with an applied metal coating.

Although Grimm et al. do not teach light reflective particles at least partly coated with Ag (i.e. silver), it is well known in the art to coat substrates such as mica or glass, with light reflective layers of the metal, silver and incorporate them into cosmetic formulations as suggested by Christie.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to coat substrates such as mica or glass with Ag because it is an obvious variation of metal that can be used as a coating on substrates in the light reflecting cosmetic compositions taught by Grimm et al.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

### ***Response to Arguments***

Applicant's arguments filed January 23, 2009 have been fully considered but they are not persuasive.

Applicant argues that Grimm et al. do not disclose or suggest the use of specific reflective particles in combination with a goniochromatic color agent in order to create highlight points visible to the naked eye and to improve volumizing effects to the lips.

This argument is not convincing. As stated above in the 103 rejection, Grimm et al. teach a makeup composition comprising the instant goniochromatic agents and additional pigments (other than the goniochromatic agent) including a substrate coated with a metal (see the abstract and page 3 paragraphs 0027 and 0029). Thus, the concept of combining the instant goniochromatic coloring agent and a natural or synthetic substrate coated with a metal is not novel. Although Grimm et al. do not specifically teach Ag (i.e. silver), Christie et al. teach that it is known in the art to layer Ag onto substrates for use in cosmetic compositions. Thus, the references combined do teach a goniochromatic agent can be combined with a substrate coated with silver. Therefore, it is the Examiner's position that since the prior art references combined teach the instant components, the composition would have the same physical properties as Applicant's composition.

Next, Applicant argues that comparative data provided in the Annex dated January 23, 2009 discloses that it would not have been obvious to one of ordinary skill in the art to select the specific reflective particles of the instant invention. Applicant has provided black and white photographs of the instant lip makeup composition and comparative compositions that uses the goniochromatic agent combined with the instant reflective particles and the same goniochromatic agent combined with glass particles coated with iron oxide.

This argument is not convincing. Applicant has not provided colored photographs of the instant composition and comparative composition to distinguish the differences between the photos. Further, Applicant has not provided a side-by-side comparison with



the closest prior art, Grimm et al. Therefore, it cannot be ascertained whether any unexpected results has been obtained.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616